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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,788	07/25/2001	Dietmar Huglin	HP/2-21868/US/A/PCT	3541

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CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
540 WHITE PLAINS RD  
P O BOX 2005  
TARRYTOWN, NY 10591-9005

EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 04/25/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	09/830,788	HUGLIN ET AL.
	Examiner	Art Unit
	Barbara P. Badio, Ph.D.	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 16, 17 and 20-26 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16, 17 and 20-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**Final Office Action on the Merits**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Objections***

2. **The objection to claim 17 under 37 CFR 1.75(c) is withdrawn.**

***Claim Rejections - 35 USC § 112***

3. **The rejection of claims 16, 20-26 and 29 under 35 USC 112, second paragraph is withdrawn.**

***Claim Rejections - 35 USC § 102***

4. **The rejection of claim 29 under 35 USC 102(a) over Luther et al. ('370) is made moot by the cancellation of the instant claim.**

5. **The rejection of claim 29 under 35 USC 102(b) over Dumler et al. (GB 2,286,774) is made moot by the cancellation of the instant claim.**

6. **The rejection of claim 29 under 35 USC 102(b) over Strobel ('132) is made moot by the cancellation of the instant claim.**

**7. The rejections of (a) claims 16, 17, 20, 21, 24 and 26 under 35 USC 102(a) over Luther et al. ('370); (b) claims 16, 20-23, 25 and 26 under 35 USC 102(b) over Dumler et al. (GB 2,286,774) and (c) claims 16, 20-22, 24 and 25 under 35 USC 102(b) over Strobel ('132) are maintained.**

Applicant argues that (a) the claimed invention is to a method of use and to compositions and (b) the cited references do not teach or suggest the use of known UV absorbers for the photolytic protection of body care products and household products. Applicant's argument was considered but not persuasive for the following reason.

Although, the instant claims are drawn to a method, the compositions produced by the incorporation of the claimed benzotriazoles and triazines into body care and household products are as taught by the cited references. In essence, the claimed invention is the discovery by applicant that said benzotriazoles and triazines impart photolytic protection to the prior art composition comprising said compounds. However, the discovery by applicant of a previously unappreciated property of a prior art composition or of a scientific explanation for the prior art's functioning does not lend patentability to a known use, i.e., incorporation of benzotriazoles and triazines into body care and household products. The fact is, even though, the prior art does not teach said photolytic protection, the ordinary artisan in the art would have the reasonable expectation that the incorporation of benzotriazoles and triazines into body care and household products as taught by the prior art would impart said photolytic protection to the prior art composition.

For this reason and those given in Paper No. 9, the rejections of (a) claims 16, 17, 20, 21, 24 and 26 under 35 USC 102(a) over Luther et al. ('370); (b) claims 16, 20-23, 25 and 26 under 35 USC 102(b) over Dumler et al. (GB 2,286,774) and (c) claims 16, 20-22, 24 and 25 under 35 USC 102(b) over Strobel ('132) are maintained.

***Other Matters***

8. Applicant statement that the election was made without traverse is incorrect (see page 5 of Paper No. 8, filed November 4, 2002).

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*Barbara Badio*  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
April 24, 2003